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Reply Brief

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Inventor : Philip F. Fox
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Examiner: K. Rowan

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APPELLANT'S BRIEF IN REPLY TO THE EXAMINER'S ANSWER

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Sir:

This is Appellant's Brief in Reply (subsequently referred to as the "Reply Brief") to the Examiner's Answer that was mailed on August 5, 2004 in the pending Appeal before the Board of Patent Appeals and Interferences regarding the Examiner's final rejection of claims 1-43 in the above-identified application. Appellant's Reply Brief, filed in accordance with 37 C.F.R. § 1.193(b), is predominantly directed to Examiner's points of argument provided in the Examiner's Answer.

In the Examiner's Answer, the Examiner merely noted that the Brief For Appellant filed on September 25, 2003 includes various statements detailing how various claims do not stand or fall together and also noted that the Brief For Appellant provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). The Examiner, in the Examiner's Answer, is required to state whether the Examiner disagrees with any statement in the Brief For Appellant that certain claims do not stand or fall together. (MPEP; 8th Ed.; May, 2004 Revision; page 1200-18). In the Examiner's Answer, the Examiner did not state whether the Examiner disagrees with any statement in the Brief For Appellant that certain claims do not stand or fall together. Therefore, Applicant presumes the Examiner agrees with all statements in the Brief For Appellant about certain claims not standing or falling together.

The Examiner's Answer reiterates rejections, previously stated in the Final Office Action dated March 25, 2003. However, the Examiner adds some claims to at least one rejection and withdraws some claims from at least another rejection, while nevertheless still providing argument for some of the claims for which rejections have apparently been withdrawn. Applicant notes the Examiner's addition of claims to a rejection amounts to a new ground of rejection that is improperly included in the Examiner's Answer, per 37 C.F.R. 1.193(a)(2). All of Appellants' arguments made in the Brief For Appellant remain valid and probative, despite any contentions of the Examiner to the contrary in the Examiner's Answer. The arguments in the Examiner's Answer add some new characterizations to the substantive argument the Examiner stated in the Final Office Action dated March 25, 2003.

The general nature and organization of the Examiner's does not follow the organization of argument presented in the Brief For Appellant. Therefore, for simplicity sake, Appellant invites the Board to rely on the Brief For Appellant as a road map to addressing the various claim rejections. In this Reply Brief, the principle thrusts of the Examiner's new arguments are addressed in a manner that (1) supplements Appellant's detailed arguments presented in the Brief For Appellant and (2) relies on the organization of argument presented in the Brief For Appellant, with the exception of modifying the rejected claim listing for each rejection per the Examiner's rejected claim listing now supplied in the Examiner's Answer.

I. The Thibodeaux Patent Does Not Anticipate Claims 1-2, 7-9, and 24-27.

A. The Examiner failed to establish that the Thibodeaux patent discloses each and every element of claims 1-2, 8, and 24-25.

The Examiner has alleged the Thibodeaux patent anticipates claims 1-2, 8, 24, and 25 under 35 U.S.C. §102(e). However, despite the Examiner's statements in support thereof, the Thibodeaux patent does not in fact anticipate any of claims 1-2, 8, 24, and 25 under 35 U.S.C. §102(e).

The Examiner's first comments in the Examiner's Answer concern claim 1, which reads as follows:

1. *An ice fishing tackle storage apparatus, the apparatus comprising:
a pair of extendable elongate shells, the extendable elongate*

shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell; and
a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.

(Emphasis added). In regard to argument concerning claim 1 provided in § I. A. of the Brief For Appellant, the Examiner alleges:

Applicant argues that the examiner has mischaracterized Thibodeaux, but that is not the case as the examiner has merely used broadest reasonable interpretation such as that the elements 12-14 of Thibodeaux can be considered as extendable elongate shells that are located adjacent to each other as shown in Fig. 1 noting that no frame of reference is stated. Also see Fig. 4. The claims of the present invention do not require that the interior surface that defines an elongate cavity is continuous. Clearly Thibodeaux shows a tube structure in Fig. 4.

(Page 7 of Examiner's Answer). Despite these comments of the Examiner, Applicant continues to believe the Examiner's basis for alleging the Thibodeaux patent anticipates claim 1 hinges on a mischaracterization of details disclosed in the Thibodeaux patent and consequently fails to establish anticipation of claim 1 by the Thibodeaux patent.

As noted in the Brief For Appellant, the Examiner characterizes the elements 12, 13, and 14, collectively, as an extendable elongate shell "having an interior surface that defines an elongate cavity." (See Thibodeaux patent, col. 2, lines 37-43; and Fig. 4). However, as Applicant set forth in the Brief For Appellant:

Continuing, the Examiner alleges the cup members 12 collectively have an interior surface "that defines an elongate cavity." This is an erroneous conclusion, since the concentric cup members 12 are in fact simply cups, where the bottom of each cup *prevents* "adjacent" cups from collectively defining an elongate cavity. (Thibodeaux patent, col. 2, line 38). The Examiner attempts to disregard this textual disclosure [of] the members 12 as "cup members" by instead merely

relying on Figure 4 of the Thibodeaux patent where the “cup” aspect of the members 12 is effectively hidden from view.

In the Examiner’s Answer, the Examiner seeks to divert attention away from the narrow disclosure of Figure 4 of the Thibodeaux patent and toward the claim 1 “elongate cavity” terminology:

The claims of the present invention do not require that the interior surface that defines an elongate cavity is continuous. Clearly Thibodeaux shows a tube structure in Fig. 4.

(Page 7 of Examiner’s Answer). However, the question is not whether the interior surface of the elongate cavity is defined in claim 1 as being continuous, but rather whether the Thibodeaux patent discloses the “elongate cavity” required by claim 1. The Thibodeaux patent merely discloses that the elements 12 in the fishing rod holder 10 constitute “a plurality of concentric cup members 12 of varying diameter.” (Thibodeaux patent, col. 2, line 38, and Fig. 4; emphasis added). The definition of “elongate” is “[adj] having notably more length than width; being long and slender.” (See Exhibit A of this Reply Brief: Hyperdictionary.com,; accessed October 4, 2004; <http://www.hyperdictionary.com/dictionary/elongate>; 2003 Webnox Corp.). The individual concentric cup members (elements 12) of the Thibodeaux patent are not long and slender and are no notably longer than wide. Instead, as expected for a “cup,” each cup member has a length that is at a maximum only about twice the diameter of the cup member. It would thus be a stretch to consider any of one of the cup members to be elongate.

The Examiner also tries to characterize the “adjacent “ language employed in claim 1 to essentially mean “far apart”:

Thibodeaux can be considered as extendable elongate shells that are located adjacent to each other as shown in Fig. 1 noting that no frame of reference is stated. Also see Fig. 4.

(Page 7 of Examiner’s Answer). Figure 4 is irrelevant, since none of the individual nested concentric cup members 12 of Figure 4 is extendable as required by claim 1: “*the pair of extendable elongate shells located adjacent to each other.*” Furthermore, the Examiner’s comments about no frame of reference is a red herring, since the different sets of nested concentric cup members 12 are located as far apart from each other on the top portion 5 of the Thibodeaux fisherman’s cooler as the top portion 5 allows. No statement of a frame of reference in claim 1 would render the different sets of nested concentric cup members 12 adjacent to each other. This observation is further supported by

the following two definitions of the word "adjacent":

1. [adj] near or close to but not necessarily touching; 'lands adjacent to the mountains'; 'New York and adjacent cities'
2. [adj] nearest in space or position; immediately adjoining without intervening space; 'had adjacent rooms'; 'in the next room'; 'the person sitting next to me'; 'our rooms were side by side'

(See Exhibit B of this Reply Brief: Hyperdictionary.com; accessed October 4, 2004; <http://www.hyperdictionary.com/dictionary/adhacent>; 2003 Webnox Corp.). The Thibodeaux patent provides the frame of reference the Examiner seeks. The Thibodeaux patent discloses that the different sets of nested concentric cup members 12 are located as far apart from each other on the top portion 5 of the Thibodeaux fisherman's cooler as the top portion 5 allows.

The foregoing comments demonstrate the Thibodeaux patent does not in fact disclose either of the extendable elongate shells with the interior surface that defines an elongate cavity, as required by claim 1. Furthermore, despite the Examiner's allegation, the fishing rod holders 10 of the Thibodeaux device are not located adjacent to each other, as claim 1 requires. Therefore, it is clear the Thibodeaux patent does not disclose the pair of extendable elongate shells that are located adjacent to each other, as required by claim 1. Consequently, the Thibodeaux patent does not show each and every element of claim 1 and therefore does not anticipate claim 1.

The Examiner's next comments in the Examiner's Answer concern claim 2, which depends from claim 1 and reads as follows:

2. The ice fishing tackle storage apparatus of claim 1 wherein the spacing structure comprises a first template, the first template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, each extendable elongate shell passing through one of the apertures of the first template.

(Emphasis added). Claim 2 thus requires a first template, where interior surfaces of the first template define "a plurality of apertures that extend through the first template." Furthermore, claim 2 requires that each extendable elongate shell pass must "through one of the apertures of the first template."

In regard to argument concerning claim 2 provided in § I. A. of the Brief For Appellant, the Examiner alleges:

In regard to claim 2, applicant argues that the bore of Thibodeaux does not extend through the top surface 5. however, the top surface can be considered to be very thin and hence, the tubes of Thibodeaux would extend through the top surface. The tubes of Thibodeaux are interlocked together by U-shaped grooves and protrusions and since a tube is shown in Fig. 1 mounted in the top surface, it can safely be assumed that members 12 do not slip through the bore. Applicant keeps insisting that the cup members of Thibodeaux can not be considered as tubes, but they certainly look like tubes in Fig. 4. Also, tubes can have closed ends like the test tubes used in chemistry labs. Since the tubes slide in one another they can be considered as male/female tubes which can be lengthened or shortened. See the description in column 2, lines 35-49.

(Page 7 to top of page 8 of Examiner's Answer). Despite these comments of the Examiner, Applicant continues to believe the Examiner's basis for alleging the Thibodeaux patent anticipates claim 2 hinges on a mischaracterization of details disclosed in the Thibodeaux patent and consequently fails to establish anticipation of claim 1 by the Thibodeaux patent.

The Thibodeaux patent describes a bore that receives the cup member 12 with the largest outside diameter. (Col. 2, lines 46-49). The bore is not depicted in any of the figures of the Thibodeaux patent. (See Thibodeaux patent, Figures 1-4). In an attempt to resuscitate a flawed rejection, the Examiner attempts to change the "template" language of claim 2 to "surface": "however, the top surface can be considered to be very thin and hence, the tubes of Thibodeaux would extend through the top surface." Claim 2 requires "*apertures that extend through the first template*" and specifies that each extendable elongate shell "*passes through one of the apertures of the first template.*" The Thibodeaux patent does not disclose anything about the bore extending through the top portion 5. Rather, all we know is that the cup members 12 rest in this bore. (Col. 2, lines 46-49). Furthermore, a mere hole in a thin surface of the top portion 5 does not amount to an aperture that extends through a template, as claim 2 requires.

The Examiner also adds the following comment: "it can safely be assumed that members 12 do not slip through the bore." (Page 7 of Examiner's Answer). It is assumed the Examiner meant to say: "it can safely be assumed that members 12 do not slip through the hole," since the Examiner is relying on a mere hole in a thin surface of the top portion 5 (rather than a non-

disclosed bore through the top portion 5) as the aperture extending through the template that claim 2 requires. Nonetheless, the Examiner's comments amount to pure speculation since the Thibodeaux patent does not say anything about there being a friction fit between the largest diameter cup member 12 and the bores.

The foregoing comments demonstrate the Thibodeaux fisherman's cooler does not include a "plurality of apertures that extend through the first template" as required by claim 2. Furthermore, it is clear the cup members 12 do not pass through the bore of the Thibodeaux fisherman cooler. Consequently, the Thibodeaux patent does not disclose the required detail of claim 2 about "each extendable elongate shell passing through one of the apertures of the first template." Consequently, the Thibodeaux patent does not show each and every element of claim 2 and therefore does not anticipate claim 2.

The Examiner's next comments in the Examiner's Answer concern claim 24, which depends from independent claim 1 and reads as follows:

24. The ice fishing tackle storage apparatus of claim 1 wherein the pair of extendable elongate shells comprise:

a first extendable elongate shell having a first interior surface that defines a first elongate cavity, the first extendable elongate shell comprising a plurality of separable elongate shell components, each elongate shell component having an inner surface that defines an elongate cavity portion, the elongate cavity portions of each adjacent elongate shell component in communication with each other and the elongate cavity portions collectively forming the first elongate cavity; and

a second extendable elongate shell having a second interior surface that defines a second elongate cavity.

(Emphasis added). Thus, claim 24 requires, for the first extendable elongate shell, that the "elongate cavity portions of each adjacent elongate shell component [be] in communication with each other" and collectively form "the first elongate cavity." The Thibodeaux patent does not disclose this aspect of claim 24 for reasons analogous to those provided in Applicant's Brief on Appeal with respect to claim 1 and claim 2. Specifically, the Thibodeaux patent discloses nested cup members 12, but does not disclose anything about these cups having elongate cavities that are in communication with each other.

The Examiner, however, alleges to the contrary in the Examiner's Answer:

In reference to claim 24, Thibodeaux shows a stacked structure of cups that make up a tube. The cups can be added to or subtracted from, so the tube can be selectively and reversibly capable of being lengthened or shortened and hence, the elongate cavity too can be lengthened or shortened.

(Middle of page 9 of Examiner's Answer).

The Examiner may want Figure 4 to disclose details about the plurality of cup members 12 collectively forming "elongate cavity portions" that are "in communication with each other" and collectively form "the first elongate cavity," as required by claim 24. Instead, consistent with the analogous reasons provided in Applicant's Brief on Appeal with respect to claim 1 and claim 2 and as explained further herein above with respect to claim 2, the Thibodeaux patent, such as in Figure 4, does not in fact show "a stacked structure of cups that make up a tube," as the Examiner alleges. Certainly, Figure 4 in combination with the text of the Thibodeaux patent discloses the Examiner's "stacked structure of cups." However, owing to the fact that the cups each have a bottom, as a cup would be expected to have, the interior portions of adjacent cups are not in communication with each other and cannot "make up a tube, as the Examiner alleges.

Consequently, and as exhaustively explained to the Examiner in the past, the Thibodeaux patent does not disclose the "elongate cavity portions of each adjacent elongate shell component in communication with each other and the elongate cavity portions collectively forming the first elongate cavity" detail required by claim 24. Therefore, the Thibodeaux patent does not show each and every element of claim 24, and consequently does not anticipate claim 24.

The Examiner's next comments in the Examiner's Answer concern claim 27, which the Examiner now apparently newly rejects under §102(e) based on the Thibodeaux patent. Claim 27, which depends from independent claim 1, reads as follows:

27. The ice fishing tackle storage apparatus of claim 26 wherein the different ice fishing tackle items are pre-rigged ice fishing rods, pre-rigged ice-fishing tip-ups, or a pre-rigged ice fishing rod and a pre-rigged ice-fishing tip-up, the ice fishing storage apparatus effective for preventing the different ice fishing tackle items from becoming entangled with each other when held within the extendable elongate shells.

(Emphasis added). Thus, claim 24 requires, for the first extendable

In regard to claim 27, now newly rejected in the Examiner's Answer under 35 U.S.C. §102(e), the Examiner, in the Examiner's Answer, alleges:

In reference to claims 27-29, elements 13-14 of Thibodeaux can be considered as stops since they stop the rotation between the concentric cup members 12. the frictional forces between the groove and the protrusion also, inherently act to hold the cups in an extended position or a selected level of extension.

(Middle of Page 9 of Examiner's Answer). The Examiner's comments above that allegedly concern claim 27 do not in fact relate to details that are recited in claim 27. The Examiner has provided no comments specifically relating to claim 27 and therefore has not established that the invention of claims 27 is anticipated by the Thibodeaux patent. Furthermore, claims 1 and 26 are believed allowable as explained herein and in Applicant's Brief on Appeal. Therefore, claim 27 is believed allowable for an additional reason, since claim 27 depends both from allowable claim 26 and from allowable claim 1.

The Thibodeaux patent does not disclose each and every detail required by any of claims 1, 2, 8, 24, 25 or 27. Claims 1, 2, 8, 24, 25, and 27 are therefore not anticipated by the Thibodeaux patent. Consequently, the Examiner erred in rejecting claims 1, 2, 8, 24, 25, and 27 under 35 U.S.C. §102(e) based on the Thibodeaux patent. Reconsideration and reversal of the rejections of claims 1, 2, 8, 24, 25, and 27 accompanied by allowance of claims 1, 2, 8, 24, 25, and 27 are respectfully requested.

B. Claims 7, 9, and 26 are each allowable because they depend from an allowable claim.

The Examiner alleged the Thibodeaux patent anticipates claims 7, 9, and 26 under 35 U.S.C. §102(e). Claims 7, 9, and 26 each depend from independent claim 1 and further define the ice fishing tackle storage apparatus. The Examiner has provided no comments specifically relating to claims 7, 9, or 26 and therefore has not established that the inventions of claims 7, 9, or 26 are anticipated by the Thibodeaux patent. Furthermore, since claims 7, 9, and 26 each depend from allowable independent claim 1, the Examiner has failed to establish that the inventions of claims 7, 9, and 26 are anticipated by the Thibodeaux patent, for the reasons provided with respect to claim 1. Consequently, the Examiner erred in rejecting claims 7, 9, and 26 under U.S.C. §102(e)

based on the Thibodeaux patent. Reconsideration and reversal of the rejections of claims 7, 9, and 26 accompanied by allowance of claims 7, 9, and 26 are respectfully requested.

II. The Wolniak Patent Does Not Anticipate Claims 10-15, 17-18, 30-34, and 37-38 Under 35 U.S.C. §102(b).

In the Examiner's Answer, the Examiner no longer stated the rejections of claims 17-18, 30-34, and 37-38 under 35 U.S.C. §102(b) based on the Wolniak patent that the Examiner had alleged as of the date Applicant's filed the Brief on Appeal. Nonetheless, since the Examiner did provide supplemental argument versus some of claims 17-18, 30-34, and 37-38, Applicant has continued to present the title sections and arguments as to claims 17-18, 30-34, and 37-38 in light of the Examiner's prior rejection of claims 17-18, 30-34, and 37-38 under 35 U.S.C. §102(b) based on the Wolniak patent.

A. The Wolniak patent does not disclose each and every element defined in claims 10, 14, 15, 30-34, and 37-38.

The Examiner has alleged the Wolniak patent anticipates claims 10, 14, 15, 30-34, and 37-38 under 35 U.S.C. §102(b). However, despite the Examiner's statements in support thereof, the Wolniak patent does not in fact anticipate any of claims 10, 14, 15, 30-34, 37, or 38-38 under 35 U.S.C. §102(b).

The Examiner's next comments in the Examiner's Answer concern claim 10, which reads as follows:

10. (Amended) An ice fishing tackle storage apparatus, the apparatus comprising:

a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, at least one of the elongate cavities having a length that is adequate to accept a portion of an ice fishing rod within the at least one elongate cavity, the ice fishing rod having a tip and a handle, a reel or a line windup attached to the ice fishing rod proximate the handle, the portion of the ice fishing rod extending from a tip of the ice fishing rod to the reel or line windup;

*a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.*

(Emphasis added). Claim 10 thus requires a pair of elongate shells that each define elongate cavities. Claim 10 further requires that at least one of the elongate cavities have a length adequate to accept a portion of an ice fishing rod, where the portion is defined as "extending from a tip of the ice fishing rod to the reel or line windup." Thus, at least one of the elongate cavities is required by claim 10 to be long enough to accept most of an ice fishing rod.

In regard to argument concerning claim 10 provided in § II. A. of the Brief For Appellant, the Examiner alleges:

In regard to claim 10, Applicant has not stated what the length that is adequate to accept a portion of an ice fishing rod. Applicant argues at length that Wolniak is for fishing lures not ice fishing rods, but provides no factual data as to what length of rod is to be stored.

(Top of page 8 of Examiner's Answer). The fact remains, the Examiner has failed to establish that the Wolniak patent discloses anything about the tubes 30 having a length that is capable of accepting the majority of an ice fishing rod, as claim 10 requires. The Examiner has failed to produce any evidence of an ice fishing rod with dimensions adequate to allow the tubes 30 to accept the majority of the ice fishing rod, as claim 10 requires. The Examiner's comments also fail to address Applicant's probative argument about the covers 20a and 20b of the Wolniak lure storage box not allowing storage of an ice fishing rod in the tubes 30. In particular, the reel or line windup parts of the rods and handle portions of the rod opposite the tip of the rod, which each may permissibly extend outside (or above) the elongate cavity of a particular elongate shell, would prevent the cover portions 20a and 20b Wolniak lure storage box from being closed.

The Examiner's further comments in support of the Examiner's rejections add little to the Examiner's rejection of claim 10 based on the Wolniak patent. The Wolniak patent clearly does not disclose each and every detail required by claim 10 and therefore does not anticipate claim 10 under 35 U.S.C. §102(b).

The Examiner's next comments in the Examiner's Answer claim 14, which depends from independent claim 10 and reads as follows:

14. (Amended) The ice fishing tackle storage apparatus of claim 10 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising one or more interior surfaces that define a recess in the wall or an aperture through the wall, the second spacing component comprising the recess or the aperture, one of the elongate shells passing through the aperture of the wall or positioned in the recess of the wall.

Claim 14 thus requires a container with a wall, where the wall has interior surfaces that define a recess in the wall or an aperture through the wall. Claim 14 further specifies that one of the elongate shells previously defined in claim 10 passes "through the aperture of the wall" or is "positioned in the recess of the wall."

In regard to argument concerning claim 14 provided in § II. A. of the Brief For Appellant, the Examiner alleges:

As to the recess in the bottom of the container of Wolniak, the area under the holes 23 is a recess. Part of the tube 30 can be considered as an elongate shell and part of the tube can be considered a socket..

(Top of page 8 of Examiner's Answer). Previously, the Examiner characterized the holes 23 as sockets:

Wolniak shows apertures or holes 23 in the bottom wall of the container which also can be considered as sockets that are joined to the elongate shells.

(Office Action dated 03/25/03, page 3, lines 15-17). Now, the Examiner has changed tactics and seeks to characterize part (but not all) of each tube 30 as a socket and "the area under the holes 23" as recesses. This new tactic does not work any better than the Examiner's initial tactic. There is no disclosure in the Wolniak patent about the "area under the holes 23" being recesses. Instead, the Wolniak patent merely discloses the bottom panel 13 as being flat and having holes 23 that extend the panel 13:

The bottom panel 13 is formed with a plurality of holes 23 therethrough which are formed to be positioned within the interior of each one of a plurality of vertically disposed display tubes 30 so that water dripping through the lures can pass out from the tackle box and air can circulate through to dry the lure.

(Col. 3, lines 14-19, and Figures 1 and 2). The Wolniak patent merely discloses positioning of an open end of the tubes 30 over the holes 23 to allow drainage of the tubes 30. Clearly, there is no disclosure in the Wolniak patent about a recess in the bottom of the container, where the tubes are positioned *in* the recess, as claim 14 requires. Likewise, there is no disclosure in the Wolniak patent about an aperture in the bottom of the container, where the tubes 30 pass *through* the aperture, as claim 14 requires. Indeed, as seen in Figure 1 of the Wolniak patent, it is clear the diameters of the holes 23 are much smaller than the diameters of the tubes 30. Furthermore there is simply no support in the Wolniak patent for the Examiner's attempt to characterize each tube 30 as being both a socket and an elongate shell.

Undoubtedly, the Wolniak patent does not disclose the recess or the aperture in the container wall that are required in the alternative by claim 14 or the relationship of the elongate shell to either the container aperture or the container recess, as required in the alternative by claim 14. Consequently, it is clear the Wolniak patent does not disclose each and every feature required by claim 14. Therefore, the Wolniak patent does not anticipate claim 14.

The Examiner's next comments in the Examiner's Answer concern claim 30, which reads as follows:

30. *An ice fishing rod storage apparatus, the apparatus comprising:*
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing rods capable of being individually positioned within the elongate cavities of the different elongate shells;
a first spacing component, the pair of elongate shells each secured by the first spacing component; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component.

In regard to argument concerning claim 30 provided in § II. A. of the Brief For Appellant, the Examiner alleges:

In reference to claim 30, this claim does not require a cover or that the cover is closed. Hence the fishing rods can be stored into the tubes 30

of Wolniak when the cover is open such as in a fishing location. The rods would then be removed when it was time to close the tackle box.

(Middle of page 8 of Examiner's Answer).

For reasons analogous to those provided above with regard to claim 10, the Wolniak patent does not in fact disclose anything about ice fishing rods being individually positionable within the tubes 30 of the Wolniak fishing tackle box, despite the Examiner's comments to the contrary. Furthermore, the Wolniak patent discloses that the covers 20a and 20b are able to be closed to contain the fishing lures stored in the tubes 30. Col. 4, lines 26-32). As previously noted, the covers 20a and 20b would not allow storage of an ice fishing rod in the tubes 30, since the reel or line windup parts of the rods and handle portions of the rods opposite the tip of the rods would prevent the cover portions 20a and 20b of the Wolniak fishing tackle box from being closed. The Wolniak patent discloses utilization of the fishing tackle box to store lures in both closed and open configurations. The Wolniak patent does not disclose utilization of the fishing tackle box in only an open configuration without at least the capability of utilizing the closed configuration, as the Examiner contends.

The Wolniak patent does not show each and every element of claim 30. Consequently, the Wolniak patent does not anticipate claim 30.

The Examiner's next comments in the Examiner's Answer concern claim 31, which depends from independent claim 30 and reads as follows:

31. The ice fishing rod storage apparatus of claim 30 wherein the ice fishing rods are capable of being individually positioned within the elongate cavities of the different elongate shells with tips of the rods within the elongate cavities and with either the reels or line windups of the ice fishing rods or fishing line extending from the reels or line windups in contact with the elongate shells.

In regard to argument concerning claim 31 provided in § II. A. of the Brief For Appellant, the Examiner alleges:

In reference to claim 31, Wolniak shows structure capable of performing the intended use.

(Middle of page 8 of Examiner's Answer).

For reasons analogous to those provided above with regard to claim 10, the Wolniak patent does not disclose the details required by claim 31 regarding the ability to position ice fishing rods in the tubes 30 in the manner defined in claim 31. Thus, the Wolniak patent does not show each and every element of claim 31. Consequently, the Wolniak patent does not anticipate claim 31.

The Examiner's next comments in the Examiner's Answer concern claim 34, which reads as follows:

34. *An ice fishing tackle storage system, the ice fishing tackle storage system comprising an ice fishing storage apparatus, the apparatus comprising:*
- a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and*
 - a first spacing component, the pair of elongate shells each secured by the first spacing component; and*
 - a first wall, the first wall attached to the first spacing component; and*
 - a container, the ice fishing tackle storage apparatus positioned in the container, the container having a second wall, the first wall and the second wall defining a chamber within the container, an ice fishing tip-up capable of being placed in the chamber.*

In regard to argument concerning claim 34 provided in § II. A. of the Brief For Appellant, the Examiner alleges:

In reference to claim 34, Wolniak shows an ice fishing tackle storage system having a pair of shells 30, 30A, each of the shells has an interior surface that defines an elongated cavity and ice fishing tackle such as the fishing lure shown in Fig. 3. Wolniak shows a first spacing component 22 and the elongate shells are each secured by the first spacing component. Wolniak shows a first wall such as a side wall attached to the first spacing component. Wolniak shows a container 10 with a first wall 12 and a second wall 13 with the elongate shells and spacing component positioned in the container as shown in Fig. 1. The first wall and the second wall define a chamber within the container that contains the elongate shells. An ice fishing tip-up is capable of being placed in one of the elongate shells which is in the container.

Also, an ice fishing tip-up can be placed between the rows of elongate shells or in the top or closure portion 20 which makes up part of the container.

(Bottom half of page 8 of Examiner's Answer).

The Examiner first alleges that placement within one of the elongate shells 30 would constitute placement within a cavity defined by the wall 12 and the bottom panel 13. This argument is flawed, since the wall 12 and the bottom panel 13 define the container itself that is required by claim 34, rather than the chamber within the container that claim 34 specifies. The Examiner's characterization thus either eliminates the container from the Wolniak device that claim 34 requires or eliminates the cavity from the Wolniak device than claim 34 requires. The Examiner's first approach is also flawed for an additional reason. Claim 34 requires a first wall and a container. The Examiner's approach uses a wall of the Wolniak container as the first wall. Therefore, the Examiner's characterization either eliminates the container from the Wolniak device that claim 34 requires or eliminates the wall from the Wolniak device than claim 34 requires.

The Examiner next alleges that "an ice fishing tip-up can be placed between the rows of elongate shells." This approach is flawed, as well. Claim 34 requires that the first wall and the second wall must define the "chamber within the container" that is capable of accepting the ice fishing tip-up. Under the Examiner's interpretation, each of the plurality of tubes disclosed in the Wolniak tackle box has a different wall that, in combination with the wall 12 of the tackle box, collectively define the single cavity existent in and around the plurality of tubes 30. Thus, rather than a first and second wall defining the chamber as required by claim 34, it is a multitude of different walls that collectively define the chamber. As for the Examiner's final contention, the capability of placing the tip-up in the covers 20a or 20b does not meet the requirements of claim 34, since the covers 20a and 20b do not have a first wall that is attached to the first spacing component, as claim 34 requires.

For the foregoing reasons, the Wolniak patent does not show each and every element of claim 34. Consequently, the Wolniak patent does not anticipate claim 34.

The Examiner's next comments in the Examiner's Answer concern claim 37, which reads as follows:

37. *An ice fishing tackle storage apparatus, the apparatus comprising:*
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; the elongate shells each having both a distal end and a proximal end;
a first spacing component, the pair of elongate shells each secured by the first spacing component, the first spacing component having a distal surface and a proximal surface; and
a second spacing component, at least one of the elongate shells secured by the second spacing component, the second spacing component spaced apart from the first spacing component;
wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a closed bottom end and an open upper end, the first spacing component positioned at the open upper end.

Thus, claim 37 defines an ice fishing tackle storage apparatus, where the ice fishing tackle storage apparatus is “positioned in a container.” Claim 37 further requires that the container have a closed bottom end.

In regard to argument concerning claim 37 provided in §. II. A. of the Brief For Appellant, the Examiner alleges:

In reference to claim 37, Wolniak shows the elongate shells and the first spacing component as discussed in reference to claim 34. Wolniak shows a second spacing component 21 located in the bottom of the container 10 below the first spacing component 22 as shown in Fig. 2. the spacing components are spaced apart from each other. Wolniak shows the container 10 having a closed bottom 13 and an open top just below rim 14. The first spacing component 22 is positioned at the open upper end just below the rim 14 as shown in Fig. 2.

(Top of page 9 of Examiner’s Answer).

The Examiner neglects to comment on the holes 23 of the Wolniak fishing tackle box. The Wolniak patent discloses the holes 23 extend through the bottom of the Wolniak fishing tackle box:

The bottom panel 13 is formed with a plurality of holes 23 therethrough which are formed to be positioned within the interior of each one of a plurality of vertically disposed display tubes 30, so that water dripping from lures can pass out from the tackle box and air can circulate through to dry the lure.

(Wolniak patent, col. 3, lines 14-19; Fig. 1; and Fig. 2). Due to the existence of these holes 23, it is clear the Wolniak patent does not disclose a container with a closed bottom end, as claim 37 requires. Therefore, the Wolniak patent does not show each and every element of claim 37 and consequently does not anticipate claim 37.

The Wolniak patent does not disclose each and every detail required by any of claims 10, 14, 15, 30-34, or 37-38. Claims 10, 14, 15, 30-34, and 37-38 are therefore not anticipated by the Wolniak patent. Consequently, the Examiner erred in rejecting claims 10, 14, 15, 30-34, and 37-38 under 35 U.S.C. §102(b) based on the Wolniak patent. Reconsideration and reversal of the rejections of claims 10, 14, 15, 30-34, and 37-38 accompanied by allowance of claims 10, 14, 15, 30-34, or 37-38 are respectfully requested.

B. Claims 11-13 and 17-18 are each allowable because they depend from an allowable claim.

The Examiner alleged the Wolniak patent anticipates claims 11-13 and 17-18 under 35 U.S.C. §102(b). Claims 11-13 and 17-18 each depend from allowable independent claim 10 and further define the ice fishing tackle storage apparatus. Since claims 11-13 and 17-18 each depend from allowable independent claim 10, the Examiner has failed to establish that the inventions of claims 11-13 and 17-18 are anticipated by the Wolniak patent, for the reasons stated above with respect to claim 10. Consequently, the Examiner erred in rejecting claims 11-13 and 17-18 under 35 U.S.C. §102(b) based upon the Wolniak patent. Reconsideration and reversal of the rejections of claims 11-13 and 17-18 accompanied by allowance of claims 11-13 and 17-18 are respectfully requested.

III. The McEwen Patent Does Not Anticipate Claims 19, 21-23, 39, Or 41.

A. The McEwen patent does not disclose each and every element defined in claims 19, 21, 23, 39, or 41.

The Examiner has alleged the McEwen patent anticipates claims 19, 21, 23, 39, and 41 under 35 U.S.C. §102(b). However, despite the Examiner's statements in support thereof, the McEwen patent does not in fact anticipate any of claims 19, 21, 23, 39, and 41 under 35 U.S.C. §102(b).

The Examiner's next comments in the Examiner's Answer concern claim 19, which reads as follows:

19. An ice fishing tackle storage apparatus, the apparatus comprising:

a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;

a spacing structure, the elongate shells secured by the spacing structure,, the spacing structure effective to maintain two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure; and

wherein at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.

Claim 19 thus requires a plurality of elongate shells that each have interior surfaces defining elongate cavities. Ice fishing tackle is capable of being positioned within the elongate cavities. A spacing structure is provided to secure two or more of the elongate shells in predetermined relation to each other, proximate the spacing structure. According to claim 19, "at least two of the elongate shells are capable of serving as legs that will stably support **the apparatus** on a surface when the at least two elongate shells are positioned in contact with the surface." (Emphasis added). Thus, at least two

of the elongate shells are capable of serving as legs that will stably support the apparatus that includes the plurality of shells and the spacing structure.

In regard to argument concerning claim 19 provided in § III. A. of the Brief For Appellant, the Examiner alleges:

As to McEwen and claim 19, inherently the tubes help support the entire apparatus since they are in contact with the ground. Note the use of the open ended term “comprising”. Further applicant has not been able to give any evidence as to how much support is given by the relative elements. The legs 40, 42 of McEwen can also be considered as part of the elongate shells and also function as legs that are in contact with the ground that contribute to stably support the apparatus on a surface. The spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure. Hence McEwen does show all of the elements recited in claim 19.

(Bottom of page 9 to top of page 10 of Examiner’s Answer).

As stated in Applicant’s Brief on Appeal, the Examiner relies upon Figure 8 of the McEwen patent as allegedly disclosing elongate shells that “are capable of serving as legs that will stably support the apparatus on a surface when the two elongate shells are positioned in contact with the surface as shown in Fig. 8.” While Figure 8 does show that a minor portion of the periphery of one end of one of the tubes 16 is in contact with the ground, this mere disclosure of the contact between this minor portion of the tube 16 with the ground does not establish anything about the ability of the tube 16, in the combination disclosed in Figure 8, to stably support the entire apparatus that includes the McEwen apparatus (i.e.: the container 10, the legs 40, 42, the tube 16, among other components).

Indeed, in relation to the disclosure in Figure 8, the McEwen patent discloses that the tubes 16, 18 by virtue of the minor contact of the tubes 16, 18 with the ground, are **not** responsible for the stability of the McEwen apparatus. Instead, the McEwen patent discloses that the bucket 10 is filled with water. (McEwen Patent, col. 4, lines 26-27). The McEwen patent discloses that this filling of the bucket with water is responsible for steadying the apparatus, including the tubes 16 and 18. (McEwen patent, col. 4, lines 42-44, and Figure 8). The McEwen patent discloses nothing whatsoever about the tubes 16, 18 supporting the overall apparatus. Indeed, the legs 40, 42 are

explicitly added for purposes of supporting the tubes 16, 18. (McEwen patent, col. 4, lines 42-44, and Figure 8). This further demonstrates the tubes 16, 18 do not support the overall apparatus of the McEwen patent, such as that disclosed in Figure 8. Mere contact of a minor portion of the tubes 16, 18 with the ground does not necessarily demonstrate support of the apparatus by the tubes 16, 18.

The Examiner then argues:

Note the use of the open ended term ‘comprising’. Further applicant has not been able to give any evidence as to how much support is given by the relative elements.

The Examiner’s comments about the “comprising language” of claim 19 is not seen as pertinent. The question is not whether the invention of the present application may include additional elements to those recited in claim 19. Instead, the question is whether the McEwen patent discloses those elements that are defined in claim 19. Claim 19 requires that:

at least two of the elongate shells are capable of serving as legs that will stably support the apparatus on a surface when the at least two elongate shells are positioned in contact with the surface, the spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure.

As explained by Applicant herein and in Applicant’s Brief on Appeal, the Examiner has not demonstrated the McEwen discloses structure with this required capability. The Examiner’s “comprising” comment merely amounts to a red herring.

As to the Examiner’s comment that “applicant has not been able to give any evidence how much support is given by the relative elements,” this is not Applicant’s responsibility. Instead, it is the Examiner’s responsibility to prove the McEwen patent discloses each and every element defined in claim 19, as Applicant noted in Applicant’s Brief on Appeal:

‘For a prior art reference to anticipate in terms of 35 U.S.C. §102, every element of the claimed invention must be identically shown in a single reference.’ In re Bond, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Furthermore, the elements disclosed by the single reference ‘must be arranged as in the claim under review.’ Bond, 15 U.S.P.Q.2d at 1567. Moreover, ‘[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims . . . and identify corresponding elements disclosed in the allegedly anticipating reference.’ Lindemann Maschinenfabrik GMBH v.

American Hoist and Derrick, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Thus, 'it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.' Ex parte Levy, 17 U.S.P.Q.2d 1461, 1462 (P.T.O. Bd. Pat. App. & Int'f 1990).

(Bottom of page 18 to top of page 19 of Applicant's Brief on Appeal). The Examiner has not carried out this burden and consequently has not established that the McEwen patent anticipates the present invention, as defined in claim 19.

Despite the explicit disclosure in the McEwen patent that the filling of the bucket of water is responsible for steadying the apparatus, including the tubes 16 and 18, and the foregoing comments of the prior three paragraphs that were submitted in response to prior Office Actions, the Examiner continues to make the groundless allegation that the minor portion of the tubes 16, 18 from Fig. 8 will stably support the overall apparatus. This allegation is not supported in fact by the McEwen patent. Instead, the McEwen patent, among other things, discloses that filling of the bucket of water is responsible for steadying the apparatus, including the tubes 16 and 18. (McEwen patent, col. 4, lines 42-44, and Fig. 8). There is nothing whatsoever in the McEwen patent that would support the Examiner's allegation that the minor contact between the tubes 16, 18 and the ground surface would allow the tubes 16, 18 to stably support the overall McEwen apparatus. This is merely an allegation of the Examiner without any basis in fact.

In the Examiner's Answer, as noted above, the Examiner also alleged:

The legs 40, 42 of McEwen can also be considered as part of the elongate shells and also function as legs that are in contact with the ground that contribute to stably support the apparatus on a surface. The spacing structure effective to prevent slippage of the at least two elongate shells with respect to the spacing structure. Hence McEwen does show all of the elements recited in claim 19.

There is no support for considering the legs 40, 42 of the McEwen patent as part of the elongate shells (tubes 16, 18). The legs 40, 42 are indirectly, though operably, attached to the tubes 16, and, respectively. The Examiner is essentially attempting to characterize the legs 40, 42 as part of the spacing structure disclosed in the McEwen patent. However, the spacing structure of the McEwen device instead includes every component shown in the figures, other than the tubes 16, 18.

(McEwen patent, col. 2, line 34, through col. 4, line 45; and Figs. 1-8). Absent these other components, including the handle 12, the nut and bolt arrangement 38, the bucket 10, the sleeve 30, 32, the elastic cords 34, 36, the sleeves 20, 22, the leg 40, 42, etc., the tubes would not be maintained in predetermined relation to each other and would not be prevented from slipping with respect to the spacing structure. All of the components beyond the tubes 16, 18 constitute the spacing structure, albeit a fairly complicated spacing structure, as explicitly disclosed in the McEwen patent.

Thus, the legs 40, 42 in combination with the water placed in the bucket 10, are vitally necessary for support of the apparatus disclosed in the McEwen patent. (McEwen patent, col. 2, line 55, through col. 3, line 5). Clearly, mere contact between a small part of the tube 16, 18 with the ground plays only a minor role and is insufficient to stably support the overall apparatus. Even absent this disclosed contact of the tubes 16, 18, the water in the bucket would clearly support the overall apparatus in stable fashion. Furthermore, absent the contact between the tube 16, 18 and the ground, the remaining components of the apparatus in the McEwen patent, including the nut and bolt mechanism 38, would still constitute the support mechanism of the McEwen apparatus and would still maintain the tubes 16, 18 in stable fashion to support a fishing rod inserted within the tube 16, 18.

As explained above, the McEwen patent does not disclose anything the tubes 16, 18 being capable of supporting the McEwen apparatus in stable fashion, despite the Examiner's speculative contention to the contrary. Consequently, the McEwen patent does not disclose anything about at least two elongate shells that "are capable of serving as legs that will stably support **the apparatus** on a surface when the at least two elongate shells are positioned in contact with the surface," as claim 19 requires. Therefore, the McEwen patent does not show each and every element of claim 19 and consequently does not anticipate claim 19.

The Examiner's next comments in the Examiner's Answer concern claim 23, which reads as follows:

23. *An ice fishing tackle storage apparatus, the apparatus comprising:*
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity, and ice fishing tackle capable of being positioned within the elongate cavities of the elongate shells;

a spacing structure, the elongate shells secured by the spacing structure, the spacing structure effective to maintain at least two of the elongate shells in predetermined relation to each other, proximate the spacing structure; and
a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, the plurality of legs attached to the spacing structure or to any of the elongate shells.

Claim 23 thus requires a plurality of legs that are capable of supporting the apparatus on a surface when the legs are positioned in contact with the surface, where the apparatus that is capable of being supported comprises the elongate shells and the spacing structure.

In regard to argument concerning claim 23 provided in § III. A. of the Brief For Appellant, the Examiner alleges:

In reference to claim 23, McEwen shows tubes 16, 18 and legs 40, 42 that contribute to the support of the entire apparatus. As to the statement that absent water in the bucket that insufficient stability would exist. McEwen states in column 4, lines 42-44 that because the bucket is partially filled with water the fishing poles will be steady. This does not state that the bucket will fall over if there is not water in the bucket, merely that the poles will be steady. This is clearly different than the bucket not being stable and falling over.

(Bottom of page 9 to top of page 10 of Examiner's Answer).

As indicated above in connection with the discussion of the Examiner's rejection of claim 19 based on the McEwen patent, there is no disclosure in the McEwen apparatus about the legs 40, 42 or the tubes 16, 18 having the capability of supporting the overall apparatus (tubes and spacing structure) of the McEwen apparatus. Instead, as exemplified by the need to fill the bucket 10 with water, it is clear the bucket, as opposed to the legs 40, 42 or the tubes 20, supports the overall apparatus that includes the bucket 10.

Despite the disclosure in the McEwen patent about the steadying effect of the water, the Examiner is essentially asserting that the bucket would be steady in the absence of the water, due to the effect of the minor contact of the tubes 16, 17 with the ground. The McEwen patent does not make this disclosure. Instead, the McEwen patent explicitly states only that, among other things,

discloses that filling of the bucket of water is responsible for steadying the apparatus, including the tubes 16 and 18. (McEwen patent, col. 4, lines 42-44, and Fig. 8). There is nothing whatsoever in the McEwen patent that would support the Examiner's allegation that the minor contact between the tubes 16, 18 and the ground surface would allow the tubes 16, 18 to stably support the overall McEwen apparatus. This is merely a speculative allegation of the Examiner without any basis in fact. Speculation is never an appropriate basis for asserting an anticipation rejection. The McEwen patent does not disclose that the tubes 16, 18 are capable of stably supporting the overall McEwen apparatus.

The foregoing comments demonstrate the McEwen patent does not show each and every element of claim 23. Consequently, the McEwen patent does not anticipate claim 23.

The McEwen patent does not disclose each and every detail required by any of claims 19, 21, 22-23, 39 or 41. Claims 19, 21, 22-23, 39 and 41 are therefore not anticipated by the McEwen patent. Consequently, the Examiner erred in rejecting claims 19, 21, 22-23, 39 and 41 under 35 U.S.C. §102(b) based on the McEwen patent. Reconsideration and reversal of the rejections of claims 19, 21, 22-23, 39 and 41 accompanied by allowance of claims 19, 21, 22-23, 39 and 41 are respectfully requested.

B. Claim 22 is allowable because claim 22 depends from an allowable claim.

The Examiner alleged the McEwen patent anticipates claim 22 under 35 U.S.C. §102(b). Claim 22 depends from allowable independent claim 19 and further defines the ice fishing tackle storage apparatus. Since claim 22 depends from allowable independent claim 19, the Examiner has failed to establish the invention of claim 22 is anticipated by the McEwen patent, for the reasons stated above with respect to claim 19. Consequently, the Examiner erred in rejecting claim 22 under 35 U.S.C. §102(b) based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 22 accompanied by allowance of claim 22 is respectfully requested.

IV. The Thibodeaux Patent and the Morin Patent Do Not Teach, Suggest, or Make Obvious the Invention of the Present Application as Defined in Claim 3.

A. Claim 3 is allowable because claim 3 depends from an allowable claim.

The Examiner alleged the Thibodeaux patent as applied to claim 1, in view of the Morin patent, renders claim 3 unpatentable under 35 U.S.C. §103. Claim 3 depends from allowable independent claim 1 and further defines the ice fishing tackle storage apparatus. Since claim 3 depends from allowable independent claim 1, the Examiner has failed to establish that the present invention, as defined in claim 3, is unpatentable over the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Consequently, the Examiner erred in rejecting claim 3 under 35 U.S.C. §103 based upon the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Reconsideration and reversal of the rejection of claim 3 accompanied by allowance of claim 3 is respectfully requested.

B. The Examiner failed to establish that the Thibodeaux patent, in view of the Morin patent, renders claim 3 *prima facie* obvious under 35 U.S.C. §103 and further failed to establish motivation for making the proposed combination.

The Examiner alleged the Thibodeaux patent as applied to claim 1, in view of the Morin patent, renders claim 3 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the Thibodeaux patent and the Morin patent, either separately or in any combination, do not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 3.

The Examiner's next comments in the Examiner's Answer concern claim 3, which reads as follows:

3. (Amended) The ice fishing tackle storage apparatus of claim 2 wherein the spacing structure further comprises a second template, the second template comprising one or more interior surfaces, the one or more interior surfaces defining at least one aperture that extends through the second template, one of the extendable elongate shells passing through the aperture of the second template.

Claim 3 thus further defines the spacing structure of claim 2 in terms of a second template in addition to the first template that is defined in claim 2. Claim 3 requires that one of the extendable elongate shells pass through the aperture of the second template.

In regard to argument concerning claim 3 provided in § IV. B. of the Brief For Appellant, the Examiner alleges:

In regard to claim 3, applicant argues that a prima facie case for obviousness has not been established. However, one skilled in the art would see the benefits from supporting the fishing rod in two places and that would be that a more stable support would be an advantage in holding a long fishing rod. As to the hindsight reconstruction, it should be pointed out that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill in art at the time the invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper. See *in re McLaughlin*, 443 R.2d 1392; 170 U.S.P.Q. 209 (CCPA 1971). Further, the additional template would support the cups of Thibodeaux, but it is not clear how this modification would open the cooler to the atmosphere as applicant contends.

(Middle to bottom of page 10 of Examiner's Answer).

Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments. There is no support for the Examiner's suggested reconstruction of the Thibodeaux fisherman's cooler. The reconstruction would apparently require incorporating the additional template inside the cooler, though the Examiner has not provided all of the details of the Examiner's suggested reconstruction. Such insertion of the additional template inside the cooler would be obtrusive and would interfere with use of the cooler as a cooler. Thus, this reconstruction to incorporate the additional template inside the cooler would destroy, or at least significantly hinder, an important and intended function of the Thibodeaux patent, namely continuing to have the full interior of the cooler available for use as a cooler. This effect on an important and intended function of the Thibodeaux fisherman's cooler demonstrates that motivation is lacking to carry out the Examiner's suggested reconstruction and combination.

The additional reconstruction of the Thibodeaux fisherman's cooler would require replacing the cup members 12 with extendable elongate shells passing through the aperture of the additional template as well as cutting through the bottom of the bores in the top portion 5 so the bores extend entirely through the top portion 5 of the Thibodeaux fisherman's cooler. Such replacement of the cup members with extendable elongate shells would destroy at least a couple of important and intended functions of the Thibodeaux fisherman's cooler. First, this reconstruction would do away with the ability to provide, and select among, several different diameter cups to match the diameter of a particular diameter rod. (Thibodeaux patent, col. 2, lines 35-40). Secondly, extending the bore through the entire thickness of the top portion 5 of the Thibodeaux fisherman's cooler would destroy, or at least significantly hinder, an important and intended function of the Thibodeaux patent, namely maximizing the ability of the cooler to keep things held within the cooler cool.

Alternatively, if the Examiner merely intends to add the additional template, while maintaining the existing groups of nested cups 12 of different diameter, such a reconstruction would not equal the invention of the present application, as defined in claim 3. The Thibodeaux patent merely discloses that the elements 12 in the fishing rod holder 10 constitute "a plurality of concentric cup members 12 of varying diameter." (Thibodeaux patent, col. 2, line 38, and Fig. 4; emphasis added). The definition of "elongate" is "[adj] having notably more length than width; being long and slender." (See Exhibit A of this Reply Brief: Hyperdictionary.com,; accessed October 4, 2004; <http://www.hyperdictionary.com/dictionary/elongate>; 2003 Webnox Corp.). The individual concentric cup members (elements 12) of the Thibodeaux patent are not long and slender and are not notably longer than wide. Instead, as expected for a "cup," each cup member has a length that is at a maximum only about twice the diameter of the cup member. It would thus be a stretch to consider any of one of the cup members to be elongate.

The foregoing comments demonstrate the Examiner's suggested combination of details from the Morin patent into the Thibodeaux fisherman's cooler is not an obvious modification. Motivation is lacking for making the suggested modifications, as detailed above. Reducing the amount of reconstruction so the Thibodeaux nested cups 12 remain does not solve the Examiner's

problem either, since the nested cups do not collectively constitute extendable elongate shells with an interior surface that defines an elongate cavity, as required by claim 3. Furthermore, despite the Examiner's comments about hindsight reconstruction, the only basis for attempting the Examiner's suggested reconstruction relies on the details of claim 3, since motivation is otherwise lacking to proceed with an attempt at the Examiner's suggested combination.

Despite the Examiner's comments in support of this rejection, the Thibodeaux patent and the Morin patent, either separately or in any combination, do not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 3. Consequently, the Examiner erred in rejecting claim 3 under 35 U.S.C. §103 based upon the Thibodeaux patent as applied to claim 1, in view of the Morin patent. Reconsideration and reversal of the rejection of claim 3 accompanied by allowance of claim 3 is respectfully requested.

V. The Thibodeaux Patent Does Not Render Claims 27-29 Obvious Under 35 U.S.C. §103.

A. Claims 27-29 are allowable because claims 27-29 reach depend from an allowable claim.

The Examiner has alleged the Thibodeaux patent renders claims 27-29 unpatentable under 35 U.S.C. §103. Claims 27-29 each depend from allowable independent claim 1 and further define the ice fishing tackle storage apparatus. Since claims 27-29 each depend from allowable independent claim 1, the Examiner has failed to establish that the present invention, as defined in claims 27-29, is unpatentable over the Thibodeaux patent. Consequently, the Examiner erred in rejecting claims 27-29 under 35 U.S.C. §103 based upon the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 27-29 accompanied by allowance of claims 27-29 is respectfully requested.

B. The Examiner failed to establish that the Thibodeaux patent renders claims 28-29 *prima facie* obvious under 35 U.S.C. §103 and motivation is lacking for modifying the Thibodeaux patent to attain the details of claims 28-29.

The Examiner has alleged the Thibodeaux patent renders claims 28-29 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the

Thibodeaux patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 28-29.

The Examiner's next comments in the Examiner's Answer concern claims 28-29, which read as follows:

28. *The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell comprises an adjustable stop, the adjustable stops effective to hold each extendable elongate shell at a selected level of extension.*

29. *The ice fishing tackle storage apparatus of claim 1 wherein each extendable elongate shell has a proximal end and a distal end, the proximal end of each extendable elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any extendable elongate shell.*

Claim 28 thus requires adjustable stops for each extendable elongate shell, where the adjustable stops are "effective to hold each extendable elongate shell at a selected level of extension." As previously explained in connection with the Examiner's rejection of claim 1 under 35 U.S.C. §102 based on the Thibodeaux patent, the Thibodeaux patent does not disclose any such extendable elongate shells, but instead merely discloses nesting cups (cup members 12). Claim 29, meanwhile, specifies that each extendable elongate shell (such extendable elongate shells are not taught, suggested, or disclosed by the Thibodeaux patent) has a rounded surface to minimize fishing line abrasion.

In regard to argument concerning claims 28-29 provided in § V. B. of the Brief For Appellant, the Examiner alleges:

In regards to claims 27-29, applicant argues that Thibodeaux even if the stops recited were adjustable that the results would not yield the claimed invention because the stops are to prevent rotation and not elongation of the cups. However, as stated above, the stops inherently have a frictional force between them which also acts to hold the cups in longitudinal alignment. However, since the Applicant also argues that there is no way that the line could come into contact with the sides of the receptacle. However, this is also incorrect since if the pole is inserted tip end down into the cup, then the line will come into contact with the walls and top edge of the receptacle. Applicant also traverses that rounded surfaces old and well known in the art. The board is invited to see Des. 261,581, notably Fig. 6 which shows rounded

surfaces to ease rod insertion and also to protect the line against abrasion are old and well known in the art.

(Bottom of page 10 to top of page 11 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments.

In reply to the Examiner's new comment about longitudinal alignment, longitudinal alignment is insufficient to demonstrate the Thibodeaux patent discloses the ability "to hold each extendable elongate shell at a selected level of extension," as claim 28 requires; longitudinal alignment is not at issue. There is no evidence of record demonstrating or even suggesting the Thibodeaux cups possess an ability to maintain a select level of extension. The Examiner's talk about "frictional force" is pure speculation.

In regard to the Examiner's new citation of Des. 261,581, only a flared opening is disclosed in this reference. (See. Figure 6). The flared opening provided in Des. 261,581 does not teach, suggest, or disclose the rounded surface defined in claim 29.

The Thibodeaux patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 28 and 29. Consequently, the Examiner erred in rejecting claims 28-29 under 35 U.S.C. §103 based upon the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 28-29 accompanied by allowance of claims 28-29 is respectfully requested.

VI. The Wolniak patent, In View Of the Thibodeaux Patent, Does Not Render Claims 1, 4-6, 16, And 43 Obvious Under 35 U.S.C. §103.

A. Claim 6 is allowable because claim 6 depends from an allowable claim.

The Examiner alleged the Wolniak patent, in view of the Thibodeaux patent, renders claim 6 unpatentable under 35 U.S.C. §103. Claim 6 depends from allowable independent claim 1 and further defines the ice fishing tackle storage apparatus. Since claim 6 depends from allowable independent claim 1, the Examiner has failed to establish that the present invention, as defined in claim 6, is unpatentable over the Wolniak patent in view of the Thibodeaux patent. Consequently, the Examiner erred in rejecting claim 6 under 35 U.S.C. §103 based upon the Wolniak in view of

the Thibodeaux patent. Reconsideration and reversal of the rejection of claim 6 accompanied by allowance of claim 6 is respectfully requested.

B. The Examiner failed to establish motivation to modify details based on the Wolniak patent, in view of the Thibodeaux patent, effective to render claims 1, 4-5, 16, and 43 obvious under 35 U.S.C. §103.

The Examiner alleged the Wolniak patent, in view of the Thibodeaux patent, renders claims 1, 4-5, 16, and 43 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the Wolniak patent and the Thibodeaux patent, either separately or in any combination, do not teach, suggest, disclose or make obvious the invention of the above-identified application, as defined in claims 1, 4-5, 16, and 43.

The Examiner's next comments in the Examiner's Answer concern claims 1, 4, and 16, which read as follows:

1. An ice fishing tackle storage apparatus, the apparatus comprising:

a pair of extendable elongate shells, the extendable elongate shells having an interior surface that defines an elongate cavity, the pair of extendable elongate shells located adjacent to each other, and ice fishing tackle capable of being positioned within the elongate cavity of each extendable elongate shell; and
a spacing structure, the pair of extendable elongate shells each secured by the spacing structure, the spacing structure effective to maintain the pair of extendable elongate shells in predetermined relation to each other, proximate the spacing structure.

4. (Amended) The ice fishing tackle storage apparatus of claim 1 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall comprising interior surfaces that define a plurality of recesses in the wall or a plurality of apertures through the wall, the spacing structure comprising the recesses or the apertures of the wall, each extendable elongate shell passing through the apertures of the wall or positioned in the recesses of the wall.

16. The ice fishing tackle storage apparatus of claim 10 wherein the elongate shells each have a longitudinal axis, a length of at least one of the elongate shells selectively and reversibly adjustable along the longitudinal axis of the at least one elongate shell.

Claim 1 thus defines an ice fishing tackle storage apparatus that comprises a pair of extendable elongate shells. The shells have an interior surface that defines elongate cavities within each shell and ice fishing tackle is capable of being positioned within each elongate cavity of each extendable elongate shell. Claim 4 thus requires a container with a wall, where the wall comprises "interior surfaces that define a plurality of recesses in the wall or a plurality of apertures through the wall," where "each extendable elongate shell either passes through the wall apertures or is positioned in the wall recesses." Claim 16 thus requires an elongate shell with a length that is selectively and reversibly adjustable along the longitudinal axis of the elongate shell.

In regard to argument concerning claims 1, 4, and 16 provided in § VI. B. of the Brief For Appellant, the Examiner alleges:

In regard to claims 1, 4 and 16 as rejected by Wolniak in view of Thibodeaux, applicant argues on page 55 that the nesting cup members of Wolniak (Thibodeaux) would not even if inserted into the tubes of 30 of Wolniak define an elongate cavity. The tube applicant further argues that the cover portions 20a and 20b would not close which would destroy an important and intended function. One skilled in the art of fishing would design the tackle box to be closed when employing an adjustable length tube by either having the extended tube length be less than the height of the tackle box or the collapsed length of the tube be shorter than the height of the tackle box. Wolniak shows walls 12, 13 and also partitions 21, 22 act as interior walls. These walls have a plurality of apertures through which the tubes 30 pass. The wall 22 acts as a top wall as shown in Fig. 2. Applicant has submitted no evidence as to why apertures in the walls 21, 22 of Wolniak can not be considered as sockets noting that sockets hold long tubular members such as bolts and the apertures in Wolniak hold tubes. Also, sockets such as wall sockets hold the prongs of a plug which are plugged in to the socket. Thus the apertures in walls 21, 22 can be considered as sockets.

(Middle of page 11 to top of page 12 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments.

First, with regard to the Examiner comments applicable to claim 1, even if the nested set of cup members 12 from the Wolniak patent were inserted in place of the tubes 30 of the Wolniak tackle box in accordance with the Examiner's suggestion, this reconstructed form of the Wolniak tackle box would not equal the present invention, as defined in claim 1. Furthermore, even if the even if the nested set of cup members 12 *were* disclosed as actually being tubes, instead of the nested cups that are actually disclosed, incorporation of such an adjustable length set of tubes in place of the individual tubes 30 disclosed in the Wolniak patent would destroy important and intended functions of the Wolniak patent.

Specifically, as previously discussed, the Wolniak patent discloses cover portions 20a and 20b that are disclosed as confronting the open upper ends of the tubes 30 to help keep fishing lures in the cups 30 in the event the tackle box of the Wolniak patent is overturned. Any incorporation of extendable length tubes in place of the fixed length tubes 30 of the Wolniak patent would either prevent the covers 20 from being closed or would prevent the covers 20 from confronting the open ends of the tube. Either way, such incorporation of extendable tubes in the Wolniak tackle box would destroy an important and intended function of the Wolniak patent, namely, either the ability to close the covers 20 or the ability to prevent lures from tumbling out of the tubes 30 upon disruption of the Wolniak tackle box.

The Examiner's suggestion:

One skilled in the art of fishing would design the tackle box to be closed when employing an adjustable length tube by either having the extended tube length be less than the height of the tackle box or the collapsed length of the tube be shorter than the height of the tackle box.

does not solve the problem, since a cover of adjustable height would be needed to solve both the problem concerning the ability to close the covers 20 and the problem of the ability to prevent lures from tumbling out of the tubes 30 upon disruption of the Wolniak tackle box. Specifically, a fixed height cover of the Examiner's suggestion would still leave destruction of at least one of the important and intended functions of the Wolniak patent. No such cover of adjustable height is suggested by any of the references.

The foregoing comments clearly demonstrate that modification of the Wolniak tackle box in accordance with the Examiner's suggestion using the Thibodeaux set of nested cups is neither taught, suggested, disclosed or obvious. Thus, the Wolniak patent and the Thibodeaux patent, either separately or in combination, do not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 1. Consequently, claim 1 is believed allowable over this §103 rejection of the Examiner.

In regard to the Examiner's comments about claim 4, as stated previously, the elements 21, 26 are disclosed in the Wolniak patent as being panels of floatation material that are added to the container, and preferably secured to the container, but are not part of the container itself. Instead, the proper focus of the Examiner would have been upon the side walls 11, the ends walls 12, or the bottom panel 13 of the container 10. However, none of the side walls 11, ends walls 12, or bottom panel 13 include any such apertures or recesses where the elongate shells pass through the apertures or are positioned in the recesses, as discussed above in regard to the Examiner's §102 rejections based on the Wolniak patent. Despite the Examiner's latest contention, the partitions 21, 22 of the Wolniak tackle box are not "interior walls" of the tackle box.

The Examiner's combination of the Wolniak patent in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the recesses or apertures that are required by claim 4. Furthermore, Applicant notes that claim 4 requires the extendable elongate shell, as previously discussed in relation to claim 1. The Examiner's combination of the Thibodeaux patent with the Wolniak patent does not teach, suggest, disclose, or render obvious the extendable elongate shell, as additionally required by claim 4.

The Examiner's combination of the Wolniak patent in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the recesses or apertures that are required by claim 4. Furthermore, Applicant notes that claim 4 requires the extendable elongate shell, as previously discussed in relation to claim 1. The Examiner's combination of the Thibodeaux patent with the Wolniak patent does not teach, suggest, disclose, or render obvious the extendable elongate shell, as additionally required by claim 4.

Despite mentioning claim 16, the Examiner's comments do not provide any comments about claim 16. The Examiner's combination of the Wolniak patent in view of the Thibodeaux patent does not teach, suggest, disclose, or make obvious the elongate shell with a length that is selectively and reversibly adjustable along the longitudinal axis of the elongate shell that is required by claim 16. The Examiner's combination of the Thibodeaux patent with the Wolniak patent therefore does not teach, suggest, disclose, or render obvious the present invention, as defined in claim 16.

The Examiner's next comments in the Examiner's Answer concern claim 43, which reads as follows:

43. *A bucket assembly, the bucket assembly comprising:
a bucket, the bucket having a water-holding capacity of at least about three gallons and the bucket having a wall, the wall having a proximal end and a distal end and the wall having an interior surface;
a plurality of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the elongate shells each secured by the first spacing component, the first spacing component in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall.*

In regard to argument concerning claim 43 provided in § VI. B. of the Brief For Appellant, the Examiner alleges:

In reference to claim 43, Wolniak shows a tackle box having a plurality of elongate shells with a first spacing component. Thibodeaux is cited to show a bucket since it is a cooler it is intended to hold ice and/or water. It would have been obvious to provide Wolniak with a bucket as shown by Thibodeaux since merely one container is being substituted for another and the function is the same.

(Top of page 12 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments.

Furthermore, any combination of details from the Thibodeaux patent and the Wolniak patent would fail to teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 43, for an additional reason. Claim 43 requires a “bucket.” Neither the Thibodeaux patent nor the Wolniak patent teaches, suggests, discloses, or motivates the use of a bucket. Instead, the Wolniak patent pertains to conventional fishing tackle boxes with flip top lids, and not buckets. On the other hand, the Thibodeaux patent relates to ice chests and coolers, as opposed to buckets. The Examiner attempts to characterize the Thibodeaux ice chest as a bucket, but, but this is a stretch of the imagination. Indeed, the definition of “bucket” is “[n] a roughly cylindrical that is vessel open at the top.” (See Exhibit C of this Reply Brief: Hyperdictionary.com,; accessed October 4, 2004; <http://www.hyperdictionary.com/dictionary/elongate>; 2003 Webnox Corp.).

Claim 43 is believed allowable. The Wolniak patent in view of the Thibodeaux patent clearly does not teach, suggest, disclose, or make obvious the invention of the above-identified application as defined in claim 43.

The Wolniak patent in view of the Thibodeaux patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 1, 4-5, 16, and 43. Consequently, the Examiner erred in rejecting claims 1, 4-5, 16, and 43 under 35 U.S.C. §103 based upon the Wolniak patent in view of the Thibodeaux patent. Reconsideration and reversal of the rejection of claims 1, 4-5, 16, and 43 accompanied by allowance of claims 1, 4-5, 16, and 43 is respectfully requested.

VII. The McEwen Patent Does Not Render Claim 20 Obvious Under 35 U.S.C. §103.

A. Claim 20 is allowable because claim 20 depends from an allowable claim.

The Examiner has alleged the McEwen patent renders claim 20 unpatentable under 35 U.S.C. §103. Claim 20 depends from independent claim 19 and further defines the ice fishing tackle storage apparatus. Since claim 20 depends from independent claim 19, the Examiner has failed to establish that the present invention, as defined in claim 20, is unpatentable over the

McEwen patent. Consequently, the Examiner erred in rejecting claim 20 under 35 U.S.C. §103 based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 20 accompanied by allowance of claim 20 is respectfully requested.

B. The Examiner failed to produce any suggestion or motivation to modify the details disclosed in the McEwen patent in a way that would render claim 20 obvious under 35 U.S.C. §103.

The Examiner alleged the McEwen patent renders claim 20 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the McEwen patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claim 20.

The Examiner's next comments in the Examiner's Answer concern claim 20, which reads as follows:

20. The ice fishing tackle storage apparatus of claim 19 wherein the ice fishing tackle storage apparatus is positioned in a container, the container having a wall, the wall having a proximal end and a distal end and the wall having an interior surface, the spacing structure either in contact with the proximal end of the wall, in contact with the interior surface of the wall, or in contact with both the proximal end of the wall and the interior surface of the wall. end of the wall and the interior surface of the wall.

In regard to argument concerning claim 20 provided in § VII. B. of the Brief For Appellant, the Examiner alleges:

In regard to claim 20 as rejected under McEwen. It should be pointed out that the disassembly of McEwen is not precluded by any of the previous claims and that disassembly of the tubes 16 and 18 and storing them in the bucket would merely be employed to store the apparatus in a smaller area when not being used.

(Middle of page 12 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments. Again, the thrust of the Examiner's latest comments does not demonstrate the McEwen patent either teaches, suggests, discloses, or renders obvious the invention of the above-identified application, as defined in claim 20.

There is no suggestion to somehow position the support structure components thereby disassembled in contact with the walls of the container 10. Clearly, the disassembled form of the McEwen apparatus would not equal the details required by claim 20. Certainly, it would not be obvious to force disassembled portions of the support structure to be in contact with the walls of the McEwen portable fish bucket. Indeed, the McEwen patent does not suggest any such disassembly. This is instead apparently only the suggestion of the Examiner. The McEwen patent instead suggests only minor disassembly with none of the components being stored in the container 10. (Col. 2, lines 43-54; and Figure 1). Thus, the McEwen patent actually teaches away from the Examiner's suggestion of complete disassembly with component storage in the bucket 10.

Based on the foregoing comments, it is clear the McEwen patent does not teach, suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 20. Therefore, Applicant believes claim 20 is allowable.

The McEwen patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claim 20. Consequently, the Examiner erred in rejecting claim 20 under 35 U.S.C. §103 based upon the McEwen patent. Reconsideration and reversal of the rejection of claim 20 accompanied by allowance of claim 20 is respectfully requested.

VIII. The Wolniak Patent Does Not Render Claims 35-36 Obvious Under 35 U.S.C. §103.

A. Claim 35 is allowable because claim 35 depends from an allowable claim.

The Examiner alleged the Wolniak patent renders claims 35 unpatentable under 35 U.S.C. §103. Claim 35 depends from allowable independent claim 34 and further defines the ice fishing tackle storage apparatus. Since claim 35 depends from allowable independent claim 34, the Examiner has failed to establish that the present invention, as defined in claim 35, is unpatentable over the Wolniak patent. Consequently, the Examiner erred in rejecting claim 35 under 35 U.S.C. §103 based upon the Wolniak patent. Reconsideration and reversal of the rejection of claim 35 accompanied by allowance of claim 35 is respectfully requested.

B. The Examiner failed to establish that the Wolniak patent renders claims 35-36 obvious under 35 U.S.C. §103.

The Examiner has alleged the Wolniak patent renders claims 35-36 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the Wolniak patent does not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 35-36.

The Examiner's next comments in the Examiner's Answer concern claims 35-36, which read as follows:

35. *The ice fishing tackle storage system of claim 34 wherein the ice-fishing tip-up is capable of being entirely within the chamber.*
36. (Amended) *An ice fishing tackle storage apparatus, the apparatus comprising:*
a pair of elongate shells, the elongate shells each having an interior surface that defines an elongate cavity and ice fishing tackle capable of being positioned within the elongate cavity of each elongate shell; and
a first spacing component, the pair of elongate shells each secured by the first spacing component;
wherein each elongate shell has a proximal end and a distal end, the proximal end of each elongate shell having a rounded surface that is adequate to minimize abrasion of any fishing line that rests against the proximal end of any elongate shell.

Claim 35 thus requires the ability to entirely place the ice-fishing tip-up within the chamber. Claim 36 thus requires the proximal end of each elongate shell have a rounded surface adequate to minimize fishing line abrasion.

In regard to argument concerning claims 35-36 provided in § VIII. B. of the Brief For Appellant, the Examiner alleges:

In regard to Wolniak in reference to claims 35-36, the chamber is the area on the inside of the tackle box and it would have been obvious to round the top surface for ease of insertion. It should be pointed out that applicant does not claim storing fishing rods or tip-ups. Claim 36 recites storing ice fishing tackle which the lure shown in Fig. 3 of

Wolniak is. Again, as stated above, the Des. 261,581 patent shows rounding the top surface of the tube as shown in Fig. 6.

(Middle of page 12 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments. First, the Examiner's contention about the Wolniak patent disclosing the chamber required by claim 35 is erroneous, as detailed above in connection with the Examiner's rejection of claim 34 under 35 U.S.C. §103 based upon the Wolniak patent. Next, the Examiner's contention about Des. 261, 581 is flawed, as explained above in relation to the Examiner's rejection of claim 29 under 35 U.S.C. §103 based upon the Thibodeaux patent.

The Wolniak patent does not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 35-36. Consequently, the Examiner erred in rejecting claims 35-36 under 35 U.S.C. §103 based upon the Wolniak patent. Reconsideration and reversal of the rejection of claims 35-36 accompanied by allowance of claims 35-36 is respectfully requested.

IX. The McEwen Patent, As Applied to Claims 19 and 23, and Further in View Of The Wolniak Patent, Does Not Render Claims 40 and 42 Obvious Under 35 U.S.C. §103.

A. Claims 40 and 42 are allowable because claims 40 and 42 each depend from an allowable claim.

The Examiner alleged the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent, renders claims 40 and 42 unpatentable under 35 U.S.C. §103. Claim 40 depends from allowable independent claim 19 and further defines the ice fishing tackle storage apparatus. Claim 42 depends from allowable independent claim 23 and further defines the ice fishing tackle storage apparatus. Since claims 40 and 42 depend from allowable independent claims 19 and 23, respectively, the Examiner has failed to establish that the present invention, as defined in claims 40 and 42, is unpatentable over the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent. Consequently, the Examiner erred in rejecting claims 40 and 42 under 35 U.S.C. §103 based upon the McEwen patent, as applied to claims 19 and 23, and further

in view of the Wolniak patent. Reconsideration and reversal of the rejection of claims 40 and 42 accompanied by allowance of claims 40 and 42 is respectfully requested.

B. The Examiner failed to establish that the McEwen Patent, as applied to claims 19 and 23, and further in view of the Wolniak Patent, renders claims 40 and 42 obvious under 35 U.S.C. §103.

The Examiner has alleged the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent, renders claims 40 and 42 unpatentable under 35 U.S.C. §103. Despite the Examiner's comments in support of this rejection, the McEwen patent and the Wolniak patent, either separately or in any combination, do not teach, suggest, disclose, or make obvious the invention of the above-identified application, as defined in claims 40 and 42.

The Examiner's next comments in the Examiner's Answer concern claim 40, which reads as follows:

40. The ice fishing tackle storage apparatus of claim 19 wherein the spacing structure comprises a template, the template comprising a plurality of interior surfaces, the interior surfaces defining a plurality of apertures that extend through the first template, at least one of the elongate shells passing through one of the apertures of the template.

Claim 40, by virtue of its dependence from claim 19, thus requires the template along with elongate shells that extend through the template.

In regard to argument concerning claims 35-36 provided in § IX. B. of the Brief For Appellant, the Examiner alleges:

In regard to claims 40 and 42, applicant argues that moving the storage template of Wolniak into the container of McEwen would hinder the storage of water in the container, but this is not seen to be the case since McEwen states that the container is only partially filled with water in column 4, lines 42-44. hence, the combination proposed would locate the template on an upper part of the bucket above the water level so that not only could live bait be stored in the bucket, also fishing tackle as well. It is not seen how employing hollow tubes with the foam template of Wolniak could cause the bucket of McEwen, now partially filled with water to become unstabilized. The combination would have the top parts of the tubes

from Wolniak extending above the top of the McEwen bucket to provide access.

(Bottom of page 12 to top of page 13 of Examiner's Answer). Applicant's comments in Applicant's Brief on Appeal remain probative and determinative despite the Examiner's latest comments.

This is a new contention by the Examiner. The Examiner never previously alleged any teaching to move the tubes 30 from the Wolniak fishing lure storage box to the interior of the McEwen container. Nevertheless, even with the Examiner's new allegation that it would be obvious to move both the templates and the tubes 30 from the Wolniak patent into the McEwen container, such a move is not taught by either the McEwen reference or by the Wolniak reference. First, such a move would destroy an important and intended function of the Wolniak patent of providing a fishing tackle box that allows ready access to fishing lures by fishermen, since the bucket of the McEwen reference is much deeper than the fishing tackle box of the Wolniak patent and would essentially bury the Wolniak tubes 30 deep in the McEwen bucket. In response to this comment of Applicant, the Examiner suggests:

The combination would have the top parts of the tubes from Wolniak extending above the top of the McEwen bucket to provide access.

However, there is no suggestion in either the McEwen patent or the Wolniak to take this approach. Instead, this is merely a suggestion of the Examiner, rather than the art, which is an insufficient basis for establishing obviousness. Furthermore, such an approach would require formation of a round two-piece cover, which is not suggested by the references of record.

Also, such a transfer of the tubes 30 and templates from the Wolniak tackle box to the McEwen bucket would destroy an important and intended function of the McEwen patent. Specifically, such a reconstruction of the McEwen structure would destroy the important and intended purpose of storing the fishing tackle outside of the container. Furthermore, such a reconstruction of the McEwen structure would inhibit or even destroy the important and intended ability to place water in the McEwen bucket for purposes of using the bucket as a bait or live well. (McEwen patent, col. 4, lines 42-44). Despite the Examiner's current comments, this purpose would be obstructed by virtue of having to remove the Wolniak structure from the McEwen bucket and set the Wolniak structure down, tackle and all, every time one seeks access to the bait or live well.

Thus, this obstruction would effectively amount to a destruction of the ability to use the bucket as a bait or live well, by virtue of using the interior of the bucket for tackle storage, rather than the exterior, as the McEwen patent teaches.

The McEwen patent and Wolniak patents, either separately or in any combination, do not teach suggest, disclose, or render obvious the invention of the above-identified application, as defined in claims 40 and 42. Consequently, the Examiner erred in rejecting claims 40-42 under 35 U.S.C. §103 based upon the McEwen patent, as applied to claims 19 and 23, and further in view of the Wolniak patent. Reconsideration and reversal of the rejection of claims 40 and 42 accompanied by allowance of claims 40 and 42 is respectfully requested.

X. Conclusion.

For the foregoing reasons the Examiner erred in rejecting claims 1-43. Reconsideration and reversal of the rejections of claims 1-43 accompanied by allowance of claims 1-43 are respectfully requested.

Respectfully submitted,

KINNEY & LANGE, P.A.

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